

REMARKS

Claims 1-8 were previously examined. Claims 1 and 5 have been amended. Claim 6 has been canceled. Claims 9-17 are added. Support for these amendments is identified in the following remarks. No new matter has been added by these amendments. Examination and reconsideration of all pending claims are respectfully requested.

Objection to the Drawings

The Examiner objected to the drawings under 37 C.F.R. § 1.83(a). The Examiner alleged that the drawings did not show a "selectively activatable repositioning system." As will be described in more detail below in regards to the rejections under 35 U.S.C. § 112, second paragraph, Applicants believe that embodiments of the selectively activatable repositioning system are illustrated in FIGS. 11, 12, 14, and 16. Consequently, Applicants do not believe that any amendments to the drawings are necessary.

Objection to the Specification

Per the request of the Examiner, Applicants have filled in the missing text on page 13, line 30.

Claim Objections

The Examiner objected to claim 6 as allegedly being unclear. While Applicants do not acquiesce to the Examiner's objection, to simplify the issues and to expedite the prosecution of the present application, Applicants have canceled claim 6. The objection to claim 6 is now moot.

Claim Rejections under 35 U.S.C. §112

Claim 6 is rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. As noted above, while Applicants do not acquiesce with the Examiner's rejections, to simplify the issues and to expedite the prosecution of the present application, Applicants have canceled claim 6. Such a rejection is now moot.

Claims 1-8 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner alleged that the "scope of 'selectively activatable repositioning system' cannot be clearly ascertained by the disclosure."

Applicants note that while claims 1-8 are broad, breadth of a claim is not to be equated with indefiniteness. See MPEP 2173.04.

While nothing in the specification and figures explicitly reference a "selectively activatable repositioning system," per MPEP § 2163.02 the subject matter of the claims need not be described literally (i.e. using the same terms or *in haec verba*).... Applicants note that the test for determining definiteness is whether the claim as a whole apprises one of ordinary skill in the art of its scope. See MPEP § 2173.02. Applicants refer the Examiner to page 33, lines 13 to page 36, line 2 and FIGS. 12, 14, and 16 which describe and illustrate the use of "a suitable input device" (page 33, line 33) that is in the form of a master clutch button 452 which interrupts the operative association between master controls (e.g., master controller workstation) and the slave (e.g., manipulator). Such a button is one of many different types of input devices that are encompassed by the selectively activatable repositioning system element of claims 1-8. A listing of the other suitable input buttons are described on page 33, line 33 to page 34, line 6.

From such portions of the specification, a person of ordinary skill in the art would see that the aforementioned portions of the detailed description sufficiently describe and illustrate the claimed "selectively activatable repositioning system," that are recited in the claims. Consequently, Applicants believe that the claims are definite and in condition for allowance.

Claim Rejections under 35 U.S.C. §102

Claims 1-8 are rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Blumenkranz et al. Such rejections are traversed in part and overcome in part as follows.

To more clearly claim the novel aspects of the present invention, Applicants have amended independent claims 1 and 5. Amended independent claim 1 provides a robotic surgical system comprising a surgical manipulator system having a manipulator movably supporting at least one surgical instrument with a plurality of degrees of freedom of movement. A master controller workstation is operatively associated with the manipulator to cause selective movement of the instrument in response to inputs from a system operator at the workstation. A selectively activatable repositioning system is configured to interrupt the operative association between the workstation and the manipulator so that the surgical instrument is movable from one position to another while the master controller workstation is held in a substantially fixed position, and to reestablish the operative association with the master controller workstation after the surgical instrument has been repositioned.

In rejecting independent claim 1, the Examiner has failed to show where Blumenkranz describes or suggests every element of claim 1. Specifically, the Examiner has not shown where Blumenkranz describes interrupting the operative association between the workstation and the manipulator so that the surgical instrument is movable from one position to another while the master controller workstation is held in a substantially fixed position. The portion of Blumenkranz that is referenced by the Examiner (col. 3, lines 4-24) describes a "brake system" that is releasable to allow for manual movement of the linkages. However, the Examiner has not shown where Blumenkranz describes a selectively activatable repositioning system configured to interrupt an operative association between the workstation and the manipulator, or that the master controller workstation is held in a substantially fixed position during the repositioning of the manipulator, as is required by independent claim 1.

Absent such a showing by the Examiner, independent claim 1 is allowable over Blumenkranz. For at least the same reasons, amended independent claim 5 and dependent claims 2-4 and 7-8 are also allowable.

Claims 1-8 are further rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Funda et al. Such rejections are traversed in part and overcome in part as follows. The portion of Funda referenced by the Examiner (col. 7, lines 15-21) merely describes that the joint axes may be released, adjusted, and relocked one at a time. Similar to Blumenkranz, the Examiner has not shown where Funda et al. describes a selectively activatable repositioning system that is configured to interrupt an operative association between the workstation and the manipulator or that the master controller workstation is held in a substantially fixed position during the repositioning of the manipulator, as is required by independent claim 1. Absent such a showing by the Examiner, amended independent claim 1 should be allowable. For at least the same reasons, independent claim 5 and dependent claims 2-4 and 7-8 are also allowable.

#### Added Claims

To more fully claim the novel aspects of the present invention Applicants have added claims 9-17. New independent claim 9 recites a robotic surgical system comprising a manipulator movably supporting at least one surgical instrument. A controller comprising an input device is operatively associated with the manipulator to cause selective movement of the instrument in response to inputs from an operator at the controller. A clutching assembly in a first mode configured to interrupt the operative association between the controller and the manipulator so that the one of the input device and the surgical instrument is moved from one position to another while the other of the input device and the surgical instrument is held in a substantially fixed position. The clutching assembly in a second mode configured to reestablish the operative association between the manipulator and the controller after the surgical instrument or input device has been repositioned. The cited references fail to describe or suggest such a system. Consequently, new independent claim 9 and dependent claims 10-16 are also allowable

over the cited reference. New independent claim 17 is a "means plus function" version of new independent claim 9 and should also be allowable.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 206-467-9600.

Respectfully submitted,

Dated: 11/29/04

By: Craig P. Wong  
Craig P. Wong  
Reg. No. 45,231

TOWNSEND and TOWNSEND and CREW, LLP  
Two Embarcadero Center, 8<sup>th</sup> Floor  
San Francisco, CA 94111  
Telephone: (206) 467-9600  
Telefax: (415) 576-0300